

U.S. Patent Application Serial No. **10/541,454**
Response filed November 5, 2009
Reply to OA dated June 10, 2009

REMARKS

Claims 12-16 are pending in this application. No amendment is made in this Response. It is believed that this Response is fully responsive to the Office Action dated June 10, 2009.

Claims 12 and 15-16 are rejected under 35 U.S.C. §103(a) as obvious over [European patents EP-102246 (EP '246) or EP-231599 (EP '599)]. (Office action paragraph no. 2)

The rejection of claims 12 and 15-16 is respectfully traversed, and reconsideration of the rejection is requested.

In the Amendment dated February 26, 2009, Applicant amended claims 12 and 16 to recite that the rare earth metal-containing magnet powder in the method has “an average particle diameter (major axis diameter) in the range of 80 μm to 200 μm ” and that the pigment has “an average particle diameter (major axis diameter) in the range of 0.01 μm to 0.5 μm .” In response, the Examiner now argues that the added particle diameter limitations “would have been obvious to one of skill in the art for the purpose of signal noise reduction in absence of unexpected results.” This is stated in paragraph no. 5 of the Office action to be a new ground of rejection.

In traversing the rejection, Applicant maintains the previously presented argument that the size of the magnet powder in EP '599 is on the scale of nanometers, for example, 0.02 to 0.20 μm in paragraph [0047] of EP '599. In EP '246, the magnetic core particles are acicular, and have an average major axial diameter of 0.05 to 0.34 μm in paragraphs [0038]-[0039]. The magnetic particles of the references are

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therefore at least 235 times smaller in diameter than those of the present claims. Applicant also argued (page 9, lines 3-7) that in the present claims, the magnetic particle size is more than 100 times the size of the pigment, while in the references, the magnetic particle size is similar to the size of the pigment.

In the rejection, the Examiner is modifying the magnetic core particle diameters in the EP '246 and EP '599 references to be increased by at least a factor of several hundred, with the stated motivation that the modification would lead to “signal noise reduction.” However, the Examiner does not cite any portion of EP '246 or EP '599, or any particular teaching in the general art, to support this statement.

Applicant submits that there is no disclosure in EP '246 or EP '599 to support the Examiner's argument. In EP '599, paragraph [0047], the plate-shaped magnetic particles are clearly stated to have a maximum diameter of $0.2\ \mu\text{m}$. Moreover, paragraph [0048] states: “When the average major axis diameter is more than $0.2\ \mu\text{m}$, the obtained magnetic composite particles may tend to become coarse particles.” Clearly, this portion of the reference **teaches away** from particles greater than $0.2\ \mu\text{m}$. A diameter of $0.2\ \mu\text{m}$ is 400 times smaller than the minimum average diameter in claim 1.

Similarly, EP '246 in paragraph [0039] clearly gives a maximum of $0.34\ \mu\text{m}$, and in paragraph [0040], explains the problem that happens when the particle is greater than $0.34\ \mu\text{m}$. Again, this is a clear **teaching away** from particles greater than $0.34\ \mu\text{m}$, which is 235 times smaller than the minimum average diameter in claim 1.

Applicant submits that it is unclear what the Examiner means by “signal noise reduction,” but it is clear that the cited references do **not** suggest that increasing the particle size will result in any particular

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improvement. The references not only do not suggest the diameter limitations of the present claims, they clearly **teach away** from these limitations and indicate that problems will be caused by exceeding the maximum diameters in the references, which are far below the minimum of the range recited in claim 1. There can be no suggestion or motivation for exceeding the stated upper limits for the diameters in the references, and claims 12 and 15-16 are not obvious over EP-102246 (EP '246) or EP-231599 (EP '599), taken separately or in combination.

Claim 14 is rejected under 35 U.S.C. §103(a) as obvious over [European patents EP-102246 (EP '246) or EP-231599 (EP '599)]. (Office action paragraph no. 3)

This rejection is respectfully traversed, and reconsideration is requested. The Examiner states that the specific weight percentages in claim 14 would have been obvious. However, Applicant has argued above that there is no suggestion or motivation in the references for the limitations of base claim 12. Claim 14 is therefore not obvious over EP-102246 (EP '246) or EP-231599 (EP '599), taken separately or in combination.

Claim 13 is rejected under 35 U.S.C. §103(a) as obvious over [European patents EP-102246 (EP '246) or EP-231599 (EP '599)] as applied to claims above, and further in view of Kageyama. (Office action paragraph no. 4)

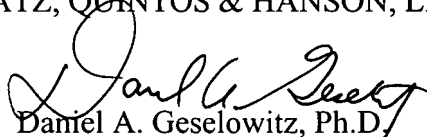
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This rejection is respectfully traversed, and reconsideration is requested. The Examiner states that Kageyama discloses obtaining by filtration a powder having adherent to the surface thereof the treating solution containing the pigment. However, Applicant has argued above that there is no suggestion or motivation in the references for the limitations of base claim 12. Claim 13 is therefore not obvious over EP-102246 (EP '246), EP-231599 (EP '599) and Kageyama, taken separately or in combination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,
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Enclosure: Petition for Extension of Time